

Office Action Summary

Application No.

10/016,477

Applicant(s)

CARTMELL ET AL.

Examiner

HARRIS C. WANG

Art Unit

2439

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☐ Claim(s) _____ is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION
Response to Arguments

The Applicant has claimed priority to the 10/357201 application, with a filing date of Feb. 4, 2003 regarding claim 1. Therefore Claim 1 has a priority date that precedes the previously cited prior art. Therefore the Examiner finds the Applicants arguments persuasive. A new rejection follows.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-15 are rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for

example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101.

Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.

Claims 16-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 16-27 are rejected as being software per se.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6-9, 11-19, 21-24, 26-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Drummond (6691156).

Regarding Claim 1, 12, 16

Drummond teaches a method for efficient handling of a blocked message in a digital traffic filtering system, the method comprising:

a. sending a notification to an authorized person about said blocking (*"The routine continues at step 314 to place the unsolicited e-mail in the holding queue associated with e-mail client. At step 316, the routine generates and issues to the sending address a new e-mail requesting a return acknowledgement"* Column 6, in particular, lines 24-27, and Figure 3)

b. including in said notification an override feature by which said authorized person can override said blocking (*"The new e-mail that is issued from the agent may include an authorization code that must be included in the return acknowledgement before the original e-mail is accepted (i.e. released from the holding queue) and delivered to the intended recipient"* Column 6, in particular lines 30-34, and Figure 3)

Regarding Claims 2-3, 17-18

Drummond teaches a method of claim 1, wherein said override feature within said notification comprises a digital code, the method further comprising sending said code to a message releasing component responsible for releasing said blocked message, in order to allow releasing of said blocked message at said message releasing component (*"The new e-mail that is issued from the agent may include an authorization code that must be included in the return acknowledgement before the original e-mail is accepted (i.e. released*

from the holding queue) and delivered to the intended recipient" Column 6, in particular lines 30-34, and Figure 3) The Examiner interprets the code for releasing said blocked message as the authorization code.

comprising sending said digital code to said message releasing component using either one of a mail reply command and a mail forward command (*The Examiner interprets the "return acknowledgement" as a mail reply command*)

Regarding Claim 4, 19

Drummond teaches a method according to claim 2, wherein said digital code is used by said message releasing component in order to identify said blocked message. (*Column 6 teaches using a code to release a blocked message. In order to release the message the message releasing component must first identify the message to be released by said authorization code*)

Regarding Claim 6, 21

Drummond teaches the method according to claim 2 comprising transferring said code to predetermined users, thereby to enable said predetermined users to release the blocked email. (*Column 6 teaches sending the code to the sender of the e-mail which the Examiner interprets as the "predetermined user"*)

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Regarding Claim 7, 22

Drummond teaches a method according to claim 2, wherein said digital code is sent to the authorized person in a manner in which it cannot be seen by said authorized person (*Column 6 teaches sending the code through e-mail. The authorized person cannot physically see the delivery of the e-mail.*)

Regarding Claim 8, 23

Drummond teaches the method according to claim 1, wherein said authorized person comprises at least one of:

The sender of the mail; (*"By issuing an e-mail to the sending address of the unsolicited e-mail, the agent tests whether the originator of this e-mail message will or can validate itself to the e-mail server"* Column 6, in particular lines 35-37)

The owner of an information item within said blocked mail;

The system administrator and

The organization security officer

Regarding Claim 9, 24

Drummond teaches a method according to claim 1, wherein said notification contains instructions with which said authorized person can release said blocked message

("Code set is responsive to a negative determination for issuing an e-mail to the sending address requesting a return acknowledgement. The e-mail may be include an authorization code that must be included in any return acknowledgement for the return to be considered authentic" Column 5, in particular lines 12-18)

Regarding Claim 11, 26

Drummond method according to claim 2, wherein an initiator of said blocked message receives a notification that does not contain said digital code. *("The e-mail may (but need not) include an authorization code" Column 5, lines 14-16)*

Regarding Claim 13-14,

A method according to claim 2, further comprising authenticating the identity of said sender of said digital code *("The sending address, which has now been verified as acceptable, is added to the user's list of approved addresses" Column 6, in particular lines 55-57)*

wherein said authenticating of said identity of said sender of said digital code is based on at least one of the following:

Said sender email address inside the organization

Said sender Media Access Control (MAC) address

A standard Public Key Infrastructure (PKI) authentication scheme

Regarding Claim 15, 27

Drummond teaches the method according to claim 2, wherein said message releasing component is a client program within a server (Column 8, lines 6-22)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 10, 20, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drummond in view of Common Knowledge.

Regarding Claim 5, 20(103)

Drummond teaches a method according to claim 2.

Drummond does not explicitly teach wherein said digital code comprises a pseudo-random series of alphanumeric characters.

The Examiner takes Official Notice that many codes are pseudo-random series of alphanumeric characters.

It would have been obvious to one of ordinary skill in the art at the time of the invention to make the authorization code of Drummond a pseudo-random series of alphanumeric characters.

The motivation is to protect against dictionary attacks.

Regarding Claim 10, 25 (103)

Drummond teaches a method according to claim 1. Drummond does not explicitly teach wherein said notification contains a copy of the blocked message

The Examiner takes Official Notice that many e-mail replies contain a copy of the original blocked message.

It would have been obvious to one of ordinary skill in the art at the time of the invention to include a copy of the blocked message in the e-mail sent to the sender.

All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods (containing a copy of a message in a reply) with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HARRIS C. WANG whose telephone number is (571)270-1462. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, KAMBIZ ZAND can be reached on (571) 272-3811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Harris C Wang/
Examiner, Art Unit 2439